REMARKS

Claims 1-12 and 36-40 were pending in this application. Claims 1 and 40 have been amended for grammatical purposes. No claims have been cancelled or added. Thus, claims 1-12 and 36-40 remain in this application.

35 U.S.C. §103 Rejections

Claims 1-6 and 36-40 stand rejected under 35 U.S.C. §103(a) for obviousness based upon U.S. Pat. Appl. Pub. No. 2001/0047294 to Rothschild (hereinafter "the Rothschild publication") in view of non-patent literature "Streaming Email" and further in view of U.S. Patent No. 6,236,395 to Sezan et al. (hereinafter "the Sezan patent")

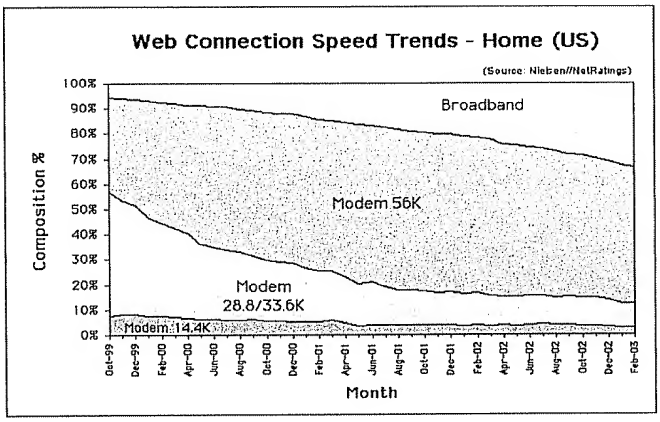
Independent claims 1 and 36 contain limitations directed to "assuring" or "confirming", respectively, that the video is in a streaming video format. The step of "assuring" or "confirming" indicates that a positive action is taken, namely, a *determination* made by analyzing a file to determine if in fact it is in a streaming video format. Although the prior art generally discloses the aspect of converting a file to a streaming video format, neither the Rothschild publication nor the Sezan patent references disclose this "assuring" or "confirming" claim limitation.

Furthermore, the Examiner states that it would have been obvious to combine the method disclosed in the Rothschild publication with the aspect of "sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format," as taught by the "Streaming Email" publication "for the benefit of sharing video messages with others that does not require transmission of the full video along with the email."

As discussed in the "Streaming Email" publication, the Video Express Email program *requires* installation of a video player by a recipient to be able to view a video transmitted by a user (i.e., the sender) of the Video Express Email program (*See* page 311, #5; page 313, FIG. 18.5; page 309, first paragraph); thus the sender is given the option to send the required player along with the video to the recipient. In contrast, the present invention does not require the use of a specialized viewer to be installed to view a transmitted video. When interpreting the patentability of a claim, the law requires that a reference be considered for all of its teachings, *including disclosure that diverges and teaches away from*

the invention at hand as well as disclosures that point toward and teach the invention. (*In re Dow Chem. Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988)) (emphasis added). Accordingly, the teaching of the "Streaming Email" publication must also include the requirement that specialized software configured to view the received proprietary video file be transmitted to and be installed at a recipient's end prior to allowing the recipient to view the video file. This is not the case in the present invention. Additionally, having an attached application be transmitted to a recipient of the email would go against the objective of minimizing the size of a file to be transmitted via email, which is one of the reasons why the video of the present invention is presented in a streaming video format (*See e.g.*, page 32, line 11 of specification). Furthermore, the video data in the Rothschild system is not indicated to be proprietary video, which would ordinarily require that specialized software be used to view it. In fact, the Rothschild publication makes no mention that the video is streaming, which according to the "Streaming Email" publication, would teach a person having ordinary skill in the art that a specialized player is required. Accordingly, the "Streaming Email" publication further teaches away from combining the streaming email aspect disclosed therein with those of ordinary video transmission disclosed in the Rothschild publication.

The Examiner uses the "thumbnail" disclosure of the Sezan patent to anticipate the claimed thumbnail limitations and to attempt to render obvious this claimed subject matter in the overall context of independent claims 1 and 36. Applicants acknowledge that thumbnails are indeed taught in the Sezan patent, however, Applicants disagree with the Examiner's asserted motivation to combine this teaching due to the teaching away aspect of the Sezan patent. Specifically, the Examiner states that modifying the methods of the Rothschild publication with those of the "Streaming Email" publication would be "for the benefit of assisting users in selecting video content for viewing..." However, it is clear that the reason for providing thumbnails in the Sezan system is actually to allow a user to easily differentiate between numerous possible video selections presented to them at one time (*See e.g.*, FIGS. 4, 5 of the Sezan patent). In contrast, claim 36 specifically sets forth the transmission in the context of an email transmission. At the time of the invention, less than 10% of U.S. households having Internet-access were connected via a broadband connection.



(*See* http://www.websiteoptimization.com/bw/0302)

Thus, Internet users would be hesitant to attach one video, let alone more than one video as an email attachment. Even if more than one video were to be sent at the time of the invention, the thumbnail aspect would not be something that one having ordinary skill in the art would think of implementing in the email attachment context since, due to the limited attachment (e.g., 1 or 2), it would not have been necessary to have thumbnails for content differentiation purposes (contrast with at least 20 videos shown to the user in FIGS. 4, 5 of the Sezan patent). Accordingly, it would not have been obvious to someone attempting to put together the claimed video sharing system in the context of email communications to implement the thumbnail teachings of the Sezan patent.

For the foregoing reasons, Applicants believe that the subject matter of independent claims 1 and 36 is not rendered obvious by the prior art of record. Reconsideration of the rejections of these claims and the claims depending therefrom is respectfully requested.

Claims 7-11 stand rejected under 35 U.S.C. §103(a) for obviousness based upon the Rothschild publication in view of the Streaming Email publication, U.S. Patent No. 6,774,926 to Ellis et al. (hereinafter "the Ellis patent"), and the Sezan patent.

The effective date of the Ellis patent is September 3, 1999 based upon the underlying provisional application filing date. The earliest effective filing date of the present application is August 3, 1999 based upon Applicants' underlying provisional application filing date, which is earlier than that of the Ellis provisional application. The Examiner asserts that the Ellis patent teaches "uploading a video segment from a sender computer system to a server computer system." This disclosed aspect, asserted by the Examiner as appearing in independent claim 7, is supported by the disclosure of Applicants' provisional application, as supported by at least pages 2-3 in the Summary of the Invention section and

pages 42-45. Accordingly, the Ellis patent was never a proper §102(b) reference to begin with and, therefore, the instant §103(a) obviousness rejection using the Ellis patent is also improper.

For the foregoing reason, Applicants believe that the obviousness rejection based upon the Rothschild publication in view of the Streaming Email publication, the Ellis patent, and the Sezan patent is improper for at least previously presented claim 7. Reconsideration of the rejections of this claim and the claims depending therefrom is respectfully requested.

REVOCATION OF POWER OF ATTORNEY

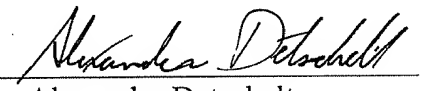
Applicants hereby submit an executed Revocation of Power of Attorney with a New Power of Attorney and Change of Correspondence Address document along with a Statement under 37 CFR 3.73(b). Applicants respectfully request that the new practitioners and correspondence address be made of record such that all future correspondence will be directed to Applicants' practitioners, namely, The Webb Law Firm.

CONCLUSION

Based on the foregoing remarks, reconsideration of the rejections and allowance of pending claims 1-12 and 36-40 are respectfully requested.

Respectfully submitted,

THE WEBB LAW FIRM

By 

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